UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,167	12/29/2000	Shin Yamaguchi	36.P289	7019

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EXAMINER
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ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/750,167	YAMAGUCHI ET AL.
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>05 July 2006</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20, 22-39, 41-57 and 59* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20, 22-39, 41-57 and 59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail. Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The Request filed on 7/5/2006 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/750,167 is acceptable and a RCE has been established. An action on the RCE follows.

Response to Amendment

2. Claims 21, 40, and 58 have been previously canceled; therefore, Claims 1-20, 22-39, 41-57, and 59 are currently pending in application 09/750,167.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. **Claims 1-8, 15-17, 20, 22-27, 34-36, 39, 41-46, 52-54, 57, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cipolla et al. (US 6,275,656 B1) in view of Masaya (JP 2000/228740), and further in view of Isobe et al. (US 5,088,586).**

5. As per **independent Claims 1 and 15**, Cipolla discloses a method [computer-executable process stored on a computer-readable medium] of renting removable digital storage media

(equivalent to the purchase of a one-time use digital camera/vending, because the user

purchases the rights to use the camera one-time before returning it for processing, C5 L7-13,

C11 L52-55) for use with a digital image acquisition device (C5 L7-13, storage media part of

one-time use camera), the method comprising [code to process] the steps of: loaning a

removable digital storage medium to a customer for insertion into a digital image acquisition

device and for storage of digital image data captured by a image acquisition device (Fig.2a,

C11 L31-55, user purchases one-time use digital camera – includes storage medium/film

unit); receiving, upon return, the removable digital storage medium from the customer (C9

L27-40, Fig.4, input device; C12 L67, C13 L1-2, film unit tendered for photofinishing).

6.   Cipolla does disclose saving and deleting data contained on the digital film unit (C14);

    however, **Cipolla fails to expressly disclose <u>selectably</u> erasing digital image data**

    contained on the returned removable digital storage medium; wherein said erasing step

    is <u>selectably</u> executed by the customer when the removable digital storage medium is

    returned, <u>such that said erasing step id executed if the customer elects to erase and is</u>

    <u>not executed if the customer elects not to erase.</u>

7.   However, Masaya discloses a digital camera recycling system, wherein the data from the

    memory is deleted once the camera is returned and the processing of the data completed. As

    described in the specification of the instant application:

> *"When the customer has finished selecting processing services, option 579 (end button)*
>
> *is selected to indicate the customer is finished. At this time the storage media is erased so*
>
> *as to prevent a later customer from having access to the images stored on a previously*
>
> *rented storage media."*

8. The system described by Masaya is equivalent to that of the instant invent, wherein the user activates the erasing step *inadvertently* by completing the photofinishing transaction (drop of media and indicate finishing preferences) with the system (translation abstract). The decision to drop the media is equivalent to *selecting to execute* the erasing step, and the decision to keep the media for later developing would be equivalent to *selecting not to execute* the erasing step.

9. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included erasing digital image data contained on the returned removable digital storage medium; wherein said erasing step is executed by the customer when the removable digital storage medium is returned, as disclosed by Masaya, in the system disclosed by Cipolla, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency and cost savings by recycling expensive merchandise through multiple loaning cycles.

10. Furthermore, although Cipolla discloses returning the film unit to the user with the processes data (C13 L10-12), the system of Cipolla is meant to encompass both a film unit (film) and a digital film unit (memory card); wherein the processed film unit (negatives) would be returned to the customer/use, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recycle the digital film unit (memory of the one-time use camera) for future customer user, as disclosed by Masaya (translated abstract), for the purposes of saving money by recycling the expensive components of the system (Cipolla: C5 L7-13, digital medium – memory card, integrated camera memory).

11. Finally, Cipolla does disclose wherein the system maintains user information in connection

with film unit identifier (C9 L27-67); however, neither Cipolla nor Masaya expressly

disclose maintaining information associated with the loan and return of the removable digital

storage medium and the customer.

12. Isobe discloses maintaining information associated with the loan and return of the removable

digital storage medium (C7 L49-61) and the customer (C5 L1-13, Return; C7 L15-30,

Rental) in an automated rental system.

13. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included maintaining information associated with the loan and

return of the removable digital storage medium and the customer, as disclosed by Isobe, in

the system disclosed by Masaya, in the system disclosed by Cipolla, for the advantage of

providing a method of renting/loaning digital storage equipment with the ability to increase

system efficiency/effectiveness by tracking the loaned assets for inventory control and loss

prevention purposes.

14. As per Claim 2, Cipolla, Masaya, and Isobe disclose wherein the removable digital storage

medium is lent at a first rental location (retail site) and received at a second rental location

(Cipolla: photo-finishing site).

15. As per Claim 3, Cipolla, Masaya, and Isobe disclose wherein the first rental location and the

second rental location are the same location (Cipolla: one-time use camera could be sold at

photo-finishing site).

16. As per Claim 4, Cipolla, Masaya, and Isobe disclose wherein the first rental location and the second rental location are different locations (Cipolla: one-time use camera could be sold at a retailer separate from the photo-finishing site).

17. As per Claim 5, Cipolla, Masaya, and Isobe disclose wherein the removable digital storage medium is associated with an identification code (Cipolla, C5-C6; Isobe: C3 L19-32, article number, bar code).

18. As per Claim 6, Cipolla, Masaya, and Isobe disclose wherein the identification code associated with the removable digital storage medium is securely stored on the removable digital storage medium, and is not erased in said erasing step (Cipolla, C5-C6; Isobe: C3 L19-22, physically attached bar code).

19. As per Claim 7, Cipolla, Masaya, and Isobe disclose wherein the maintaining step further comprises assigning the identification code to the removable digital storage medium (Isobe: C3 L19-32, saving article number to database).

20. As per Claim 8, Cipolla, Masaya, and Isobe disclose wherein the maintaining step further comprises: assigning an identification code to the customer; associating the identification code of the removable digital storage medium with the identification code of the customer when the customer is lent the removable digital storage medium; and dissociating the identification code of the removable digital storage medium and the identification code of the customer when the removable digital storage medium is received from the customer (Isobe: Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30).

21. As per Claim 16, Cipolla, Masaya, and Isobe disclose wherein the processing step further

    comprises making the digital data contained on the received removable digital storage

    medium available to the customer (Cipolla: C13 L1-18, Final images returned to customer).

22. As per Claim 17, Cipolla, Masaya, and Isobe disclose wherein the processing step further

    comprises the steps of: transferring the digital data contained on the removable digital

    storage medium; and providing the other digital storage medium containing the transferred

    data to the customer (Masaya: Translated Abstract, supplies read data to user in a desired

    output).

23. As per Claim 20, Cipolla, Masaya, and Isobe disclose wherein the digital data is digital

    image data, and wherein the processing step further comprises printing the digital data

    contained on the removable digital storage medium received from the customer using an

    image forming apparatus (Cipolla: C4 L35-39, C13 L1-18).

24. As per Claim 22, Cipolla, Masaya, and Isobe disclose wherein the processing step further

    comprises the step of verifying the functionality of the received removable digital storage

    medium (Masaya: Translated Abstract, part of recycling process).

25. **As per independent Claims 23, 34, 42, and 52,** Cipolla discloses a computer-executable

    process stored on a computer-readable medium [system], the computer-executable process

    steps to effect rental of a removable digital storage medium (equivalent to the purchase of a

    one-time use digital camera/vending, because the user purchases the rights to use the camera

    one-time before returning it for processing, C5 L7-13, C11 L52-55) [at a first rental location]

    (Retail location) to a customer for insertion into a digital image acquisition device and

    storage of digital image data captures by the digital image acquisition device (C5 L7-13,

storage media part of one-time use camera) and to receive, upon return [to a second rental location] (Photo-finishing unit), the removable digital storage medium from the customer (C9 L27-40, Fig.4, input device; C12 L67, C13 L1-2, film unit tendered for photofinishing); the system comprising a processing system [code] for processing the digital image data on returned ones of said rented removable digital storage media (C13 L1-7, receive and process).

26. Cipolla does disclose saving and deleting data contained on the digital film unit (C14); however, Cipolla fails to expressly disclose a processing system [code] for processing the digital image data on returned ones of said rented removable digital storage media including an erasure subsystem for <u>selectable</u> erasure of digital image data thereon; wherein said erasure subsystem [code] is configured for <u>selectable</u> activation by the customer, **such that erasure is executed if the customer elects to erase and is not executed if the customer elects not to erase.**

27. However, Masaya discloses a digital camera recycling system, wherein the data from the memory is deleted once the camera is returned and the processing of the data completed. As described in the specification of the instant application:

> *"When the customer has finished selecting processing services, option 579 (end button) is selected to indicate the customer is finished. At this time the storage media is erased so as to prevent a later customer from having access to the images stored on a previously rented storage media."*

28. The system described by Masaya is equivalent to that of the instant invent, wherein the user activates the erasing step *inadvertently* by completing the photofinishing transaction (drop of media and indicate finishing preferences) with the system (translation abstract). The decision

to drop the media is equivalent to *selecting to execute* the erasing step, and the decision to keep the media for later developing would be equivalent to *selecting not to execute* the erasing step.

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a processing system [code] for processing the digital image data on returned ones of said rented removable digital storage media including an erasure subsystem for erasure of digital image data thereon; wherein said erasure subsystem [code] is configured for activation by the customer, as disclosed by Masaya, in the system disclosed by Cipolla, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase system efficiency and cost savings by recycling expensive merchandise through multiple loaning cycles.

30. Furthermore, although Cipolla discloses returning the film unit to the user with the processes data (C13 L10-12), the system of Cipolla is meant to encompass both a film unit (film) and a digital film unit (memory card); wherein the processed film unit (negatives) would be returned to the customer/use, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recycle the digital film unit (memory of the one-time use camera) for future customer user, as disclosed by Masaya (translated abstract), for the purposes of saving money by recycling the expensive components of the system (Cipolla: C5 L7-13, digital medium – memory card, integrated camera memory).

31. Finally, Cipolla does disclose wherein the system maintains user information in connection with film unit identifier (C9 L27-67); however, neither Cipolla nor Masaya expressly

disclose maintenance system [code] for maintaining information associated with the rental

and return of returned ones of the removable digital storage media and the customer.

32. Isobe discloses maintaining information associated with the loan and return of the removable

digital storage medium (C7 L49-61) and the customer (C5 L1-13, Return; C7 L15-30,

Rental) in an automated rental system.

33. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included disclose maintenance system [code] for maintaining

information associated with the rental and return of returned ones of the removable digital

storage media and the customer, as disclosed by Isobe, in the system disclosed by Masaya, in

the system disclosed by Cipolla, for the advantage of providing a method of renting/loaning

digital storage equipment with the ability to increase system efficiency/effectiveness by

tracking the loaned assets for inventory control and loss prevention purposes.

34. As per Claim 24, Cipolla, Masaya, and Isobe disclose wherein the removable digital storage

medium is associated with an identification code (Isobe: C3 L19-32, article number, bar

code).

35. As per Claim 25, Cipolla, Masaya, and Isobe disclose wherein the identification code

associated with the removable digital storage medium is securely stored on the removable

digital storage medium, and is not erased by said processing step (Isobe: C3 L19-22,

physically attached bar code).

36. As per Claim 26, Cipolla, Masaya, and Isobe disclose wherein the maintenance system

further comprises: an assignment system that assigns an identification code to the removable

digital storage medium (Isobe: C3 L19-32, saving article number to database).

37. As per Claim 27, Cipolla, Masaya, and Isobe disclose wherein the maintenance system

    further comprises: an assignment system that assigns an identification code to the customer;

    and an association system that associates the identification code of the removable digital

    storage medium with the identification code of the customer when the customer is lent the

    removable digital storage medium; and dissociates the identification code of the removable

    digital storage medium and the identification code of the customer when the removable

    digital storage medium is received from the customer (Isobe: Renting/Return Process, C4

    L51-67, C5 L1-13, C7 L15-30).

38. As per Claims 35, and 53, Cipolla, Masaya, and Isobe disclose wherein the processing step

    further comprises a producing system for making the digital data contained on the received

    removable digital storage medium available to the customer (Cipolla: C11 L1-20, Data

    Processing for the customer).

39. As per Claims 36, and 54, Cipolla, Masaya, and Isobe disclose a transfer system that

    transfers the digital data contained on the removable digital storage medium received from

    the customer to another digital storage medium (generating stills – transfer to printer); and a

    provision system that provides the other digital storage medium containing the transferred

    data to the customer (Cipolla: C11 L1-20, Data Processing for the customer).

40. As per Claims 39, and 57, Cipolla, Masaya, and Isobe disclose wherein the digital data is

    digital image data, and wherein the processing step further comprises a print system that

    prints the digital data contained on the removable digital storage medium received from the

    customer (Cipolla: C11 L1-20, Generating Prints).

41. As per Claims 41, and 59, Cipolla, Masaya, and Isobe disclose wherein the processing step

    further comprises the step of verifying the functionality of the received removable digital

    storage medium (Masaya: Translated Abstract, part of recycling process).

42. As per Claim 43, Cipolla, Masaya, and Isobe disclose wherein the removable digital storage

    medium is associated with an identification code (Isobe: C3 L19-32, article number, bar

    code).

43. As per Claim 44, Cipolla, Masaya, and Isobe disclose wherein the identification code

    associated with the removable digital storage medium is securely stored on the removable

    digital storage medium, and is not erased in said erasing step (Isobe: C3 L19-22, attached bar

    code).

44. As per Claim 45, Cipolla, Masaya, and Isobe disclose wherein the code to maintain further

    comprises code to assign an identification code to the removable digital storage medium

    (Isobe: C3 L19-32, saving barcode info as article number).

45. As per Claim 46, Cipolla, Masaya, and Isobe disclose code to assign an identification code to

    the customer; code to assign the identification code of the removable digital storage medium

    with the identification code of the customer when the customer is lent the removable digital

    storage medium; and code to dissociate the identification code of the removable digital

    storage medium and the identification code of the customer when the removable digital

    storage medium is received from the customer (Isobe: Renting/Return Process, C4 L51-67,

    C5 L1-13, C7 L15-30).

46. <u>Claims 9-11, 28-30. 47, and 48</u> are rejected under 35 U.S.C. 103(a) as being

unpatentable over Cipolla in view of Masaya, in view of Isobe, and further in view of

Zander (US 5,923,906).

47. As per Claim 9, 28, and 47, while Isobe discloses monitoring rental merchandise by

including or removing merchandise identification information from inventory (Isobe:

Renting/Return Process, C4 L51-67, C5 L1-13, C7 L15-30); Cipolla, Masaya, and Isobe fail

to expressly disclose wherein the maintaining step further comprises: removing the

identification code of the removable digital storage medium from inventory of the first rental

location when the removable digital storage medium is lent by the first rental location to the

customer; and adding the identification code of the removable digital storage medium to

inventory of the second rental location when the removable digital storage device is received

by the second rental location.

48. However, Zander discloses an automated vending (renting/loaning) system, which maintains,

associates, and transfers merchandise identification data with vending machine identification

data (C8 L27-34, C16 L32-50, C19 L34-38).

49. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included wherein the maintaining step further comprises:

removing the identification code of the removable digital storage medium from inventory of

the first rental location when the removable digital storage medium is lent by the first rental

location to the customer; and adding the identification code of the removable digital storage

medium to inventory of the second rental location when the removable digital storage device

is received by the second rental location, as disclosed by Zander, in the system disclosed by

Isobe, in the system disclosed by Masaya, in the system disclosed by Cipolla, for the

advantage of providing a method of renting/loaning digital storage equipment with the ability

to increase customer reach of the system, and efficiency and effectiveness of the system, by

maintaining, tracking, and balancing inventories over a multitude of vending sites.

50. As per Claim 10 and 29, Cipolla, Masaya, Isobe, and Zander disclose wherein information

associated with the inventories of the first and second rental locations is stored in a data

store, which is accessible by any of a plurality of rental locations (Zander: C16 L32-50,

Distribution Center).

51. As per Claim 11, 30 and 48, Cipolla, Masaya, Isobe, and Zander wherein the maintaining

step further comprises the steps of: assigning the identification code of a removable digital

storage medium with the identification code of a rental location when the rental location

receives the removable digital storage medium; and disassociating the identification code of

removable digital storage medium from the identification code of a rental location when the

rental location lends the removable digital storage medium (Isobe: Renting/Return Process,

C4 L51-67, C5 L1-13, C7 L15-30).

52. **Claims 12-14, 31-33, and 49-51 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Cipolla in view of Masaya, in view of Isobe, in view of Zander, and

further in view of Jones (US 6,292,213 B1).

53. As per Claim 12, 31, and 49, Cipolla, Masaya, Isobe, and Zander fail to expressly disclose

balancing the inventory of the first and second rental locations.

54. However, Jones discloses a rental system, wherein several rental locations share inventory to

maintain proper levels (C3 L48-67, C4 L1-11).

55. Therefore, it would have been obvious to one of ordinary skill in the art at the time the

invention was made to have included balancing the inventory of the first and second rental

locations, as disclosed by Jones, in the system disclosed by Zander, in the system disclosed

by Isobe, in the system disclosed by Masaya, in the system disclosed by Cipolla, for the

advantage of providing a method of renting/loaning digital storage equipment with the ability

to increase system effectiveness and efficiency by ensuring that product is available at

locations for customers to purchase/rent.

56. As per Claim 13, 32, and 50, Cipolla, Masaya, Isobe, Zander, and Jones discloses wherein

the balancing step further comprising the steps of: determining a number of removable digital

storage medium located at each of the first and second rental locations; and transferring

removable digital storage medium from the first rental location to the second rental location

when it is determined that the first rental location has an excess number of removable digital

storage medium and the second rental location has a deficient number of removable digital

storage medium (Jones: C3 L48-67, C4 L1-11, sharing inventory).

57. As per Claim 14, 33, and 51, Cipolla, Masaya, Isobe, Zander, and Jones disclose wherein the

balancing step further comprising requesting a transfer of removable digital storage medium

from a first rental location by a second rental location when it is determined that the second

rental location has a deficient number of removable digital storage medium (Jones: C3 L48-

67, C4 L1-11, sharing inventory).

58. **Claims 18-19, 37-38, and 55-56 are rejected under 35 U.S.C. 103(a) as being**

unpatentable over Cipolla in view of Masaya, in view of Isobe, and further in view of

Shiota et al. (US 6,337,712 B1).

59. As per Claims 18, 37, and 55, Cipolla, Masaya, and Isobe fail to expressly disclose wherein the processing step further comprises the steps of: uploading the digital data contained on the removable digital storage medium received from the customer to a computer server; and providing the customer with access to the computer server.

60. Shiota discloses uploading digital data contained on a removable digital storage medium received from a customer to a computer server; and providing the customer with access to the computer server (C6 L30-47).

61. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises the steps of: uploading the digital data contained on the removable digital storage medium received from the customer to a computer server; and providing the customer with access to the computer server, as disclosed by Shiota, in the system disclosed by Isobe, in the system disclosed by Masaya, in the system disclosed by Cipolla, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase customer service, efficiency, and effectiveness of the system, by supplying the customer with several ways to receive processed digital data.

62. As per Claims 19, 38, and 56, Cipolla, Masaya, Isobe fail to disclose wherein the processing step further comprises emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer.

63. Shiota discloses emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer (C6 L30-47).

64. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included wherein the processing step further comprises emailing the digital data contained on the removable digital storage medium received from the customer to one or more email accounts specified by the customer, as disclosed by Shiota, in the system disclosed by Isobe, in the system disclosed by Masaya, in the system disclosed by Cipolla, for the advantage of providing a method of renting/loaning digital storage equipment with the ability to increase customer service, efficiency, and effectiveness of the system, by supplying the customer with several ways to receive processed digital data.

Response to Arguments

65. Applicant's arguments filed 7/5/2006, with respect to Claims 1-20, 22-39, 41-57, and 59, have been considered but are not persuasive. The rejection will remain as Non-Final, based on the sited prior art.

66. The Applicant makes the argument that the sited prior art fails to teach or suggest that said erasing step is executed if the customer elects to erase and is not executed if the customer elects not to erase.

67. However, Masaya discloses a digital camera recycling system, wherein the data from the memory is deleted once the camera is returned and the processing of the data completed. As described in the specification of the instant application:

> *"When the customer has finished selecting processing services, option 579 (end button)*
>
> *is selected to indicate the customer is finished. At this time the storage media is erased so*
>
> *as to prevent a later customer from having access to the images stored on a previously*
>
> *rented storage media."*

68. The system described by Masaya is equivalent to that of the instant invent, wherein the user

activates the erasing step *inadvertently* by completing the photofinishing transaction (drop of

media and indicate finishing preferences) with the system (translation abstract). The decision

to drop the media is equivalent to *selecting to execute* the erasing step, and the decision to

keep the media for later developing would be equivalent to *selecting not to execute* the

erasing step.

69. The Applicant should better disclose in the independent claims the purpose for not executing

the erasing step, to give more weight to the element as part of the complete process (Instead

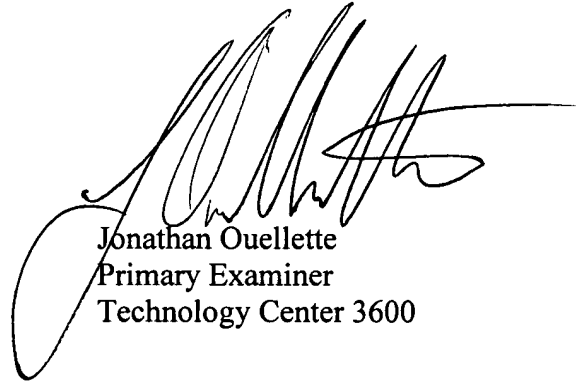of a simply mental decision made by the user)

Conclusion

70. The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

71. Additional Literature has been referenced on the attached PTO-892 form, and the Examiner

suggests the applicant review these documents before submitting any amendments.

72. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The

examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

73. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

   John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization

   where this application or proceeding is assigned (571) 273-8300 for all official

   communications.

74. Any inquiry of a general nature or relating to the status of this application or proceeding

   should be directed to the Office of Initial Patent Examination whose telephone number is

   (703) 308-1202.

September 13, 2006

                                          Jonathan Ouellette
                                          Primary Examiner
                                          Technology Center 3600